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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/612,515

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EXAMINER

TYSON, MELANIE RUANO

ART UNIT

PAPER NUMBER

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/612,515	<b>Applicant(s)</b> STONE ET AL.	
	<b>Examiner</b> Melanie Tyson	<b>Art Unit</b> 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9, 19, 20, 22-24, 39, 40, 42-61 and 64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 19, 20, 22-24, 39, 40, 42-61 and 64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This action is in response to the applicant's amendment received on 23 September 2008. Claims 10-18, 21, 25-38, 41, 62, and 63 are canceled. New claim 64 has been added. Corrections made to the claims have been accepted.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 1-9, 19, 20, 22-24, 39, 40, and 42-61 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-7, 19, 20, 22-24, 39, 40, 42, 43, 45-48, 51, 53-55, and 58-61** are rejected under 35 U.S.C. 102(b) as being anticipated by **Morgan et al. (U.S. Publication No. 2002/0052629 A1)**. Morgan discloses a suture anchor (see entire document) comprising a single unit formed of stainless steel (for example, see paragraph 33) having a bone [anatomical] engaging section (12) with a bone [anatomical] engaging structure (threaded portion 18) defining a maximum diameter (for example, see Figure 4), a suture engaging section (for example, see Figure 3; starts at the portion at which the threads end and up, including the surface in which the eyelets are formed) extending from the bone [anatomical] engaging section and wherein an outermost annular surface defines a diameter less than the maximum diameter (for

example, see Figure 4) such that it is able to be substantially disposed below an exterior surface of a boney structure after implantation (for example, see Figure 2), a first and second enclosed eyelet in a single wall of the suture engaging section that is substantially transverse to the bone engaging axis (top wall surface when two halves are fastened together) formed to allow a selected portion of a suture to pass through the suture engaging section, and a suture passage (u-shaped portion) interconnecting the first and second eyelets operable to allow a suture to enter and exit the suture engaging section from a single section (top section) such that the selected portion of the suture remains substantially within the maximum diameter. The eyelets are capable of being substantially exposed after implantation since they are formed on the top wall and the suture is positionable through the eyelets and passage such that the suture is able to extend from the suture engaging section generally parallel and along an axis of the anatomical engaging section. With further respect to claims 2 and 48, it has been held that the term "integral" is sufficiently broad to embrace constructions united by means such as fastening and welding, which Morgan discloses. With further respect to claim 20, the two halves are formed of the same material and are fastened together, thus form a single piece of a single material. With further respect to claim 39, the suture engaging section is considered to be spaced a distance axially from the bone [anatomical] engaging section in that it lacks threads.

**Claims 1, 2, 4, 5, 7, 9, 19, 20, 23, 24, 39, 40, 42, 44, 45, 47, 48, 51, 54, 55, and 58-60** are rejected under 35 U.S.C. 102(b) as being anticipated by **Ballintyn et al. (U.S. Patent No. 5,584,836)**. Ballintyn discloses a suture anchor (see entire document)

Art Unit: 3773

comprising a single unit of a single material having a bone [anatomical] engaging section (31; portion with threads) with a bone [anatomical] engaging structure (threaded portion 32) defining a maximum diameter (for example, see Figure 3B), a suture engaging section (31; portion with eyelets) extending from the bone [anatomical] engaging section and wherein an outermost annular surface defines a diameter less than the maximum diameter (for example, see Figure 3B) such that it is able to be substantially disposed below an exterior surface of a boney structure after implantation, a first and second enclosed eyelet in a single wall (outside wall) of the suture engaging section formed to allow a selected portion of a suture to pass through the suture engaging section, and a suture passage (portion between eyelets) interconnecting the first and second eyelets operable to allow a suture to enter and exit only the suture engaging section from a single section (suture engaging section) such that the selected portion of the suture remains substantially within the maximum diameter. The suture is positionable through the eyelets and passage such that the suture is able to extend from the suture engaging section generally parallel and along an axis of the anatomical engaging section. With further respect to claims 2 and 48, it has been held that the term "integral" is sufficiently broad to embrace constructions united by means such as fastening and welding, which Ballintyn discloses. With further respect to claim 39, the suture engaging section is considered to be spaced a distance axially from the bone [anatomical] engaging section in that it lacks threads.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claim 64** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Morgan et al.** It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the anchor with third and fourth eyelets and a second passage connecting the third and fourth eyelets, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

**Claim 64** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ballintyn et al.** It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the anchor with third and fourth eyelets and a second passage connecting the third and fourth eyelets, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

**Claims 6, 8, 22, 43, 46, 49, 50, 52, 53, 56, 57, and 61** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ballintyn et al.** as applied to claims 1, 17, and 47 above, and further in view of **Stone et al. (U.S. Patent No. 6,139,565)**. Ballintyn discloses the claimed invention except for eyelets positioned as claimed and a suture passage that allows a suture to be passed exterior of the suture engaging section at a point other than the eyelets. Stone et al. discloses a suture anchor (see entire document). Stone teaches eyelets (19) formed on a proximal face of the suture engaging portion that comprises a surface transverse to the bone engaging axis configured to extend away from the bone engaging section (for example, see Figure 12A and 12B). Stone further teaches the suture passage allows a suture to be passed to an exterior at a point other than the first and second eyelets configured to allow access to the suture passage through the sidewall (for example, see Figure 12B; portion 18 extends through from one sidewall surface to and through an opposite sidewall surface). It is well within the general knowledge of one having ordinary skill in the art to apply a known technique to a known device ready for improvement to yield predictable results. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form Ballintyn's anchor as taught by Stone. Doing so would enable the user to access the suture at a position other than the eyelets and also enable the user to have access to the suture after implantation, thus enabling the user to work with the suture after implantation without having to remove the bone anchor and further preventing suture chafing once the anchor has been implanted.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Thursday 8:30-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for



Art Unit: 3773

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./  
Examiner, Art Unit 3773  
December 12, 2008

/(Jackie) Tan-Uyen T. Ho/  
Supervisory Patent Examiner, Art Unit 3773